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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,814	01/30/2004	Min-Yi Liu	BHT-3106-308	3135
7590	10/05/2004		EXAMINER	
TROXELL LAW OFFICE PLLC SUITE 1404 5205 LEESBURG PIKE FALLS CHURCH, VA 22041			HESS, DANIEL A	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/766,814	LIU, MIN-YI	
	Examiner Daniel A Hess	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 December 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-6 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claims 1-6 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) must be in one sentence form only. The claims must not include conversational or informal language. Appropriate clarification and correction is required.

In claim 1, phrases such as “can be,” “at the same time,” and “thus” are all informal language which is improper and should be removed. Verbs are also present which detract from the clarity of the claim and generally claims do not have verbs.

Claims 2-6 require similar corrections. In claim 5, the language “like... etc” is especially improper.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu (US 6,561,421) in view of Chao (US 6,773,192).

Re claim 1: Yu teaches (see figure 5 especially; column 2, lines 59-61) a card reader that is elongated and in the shape of a pen. Slits/slots 52 receive cards in various formats and a USB connector is present at the end of the cylinder. The exposed USB connector is connectable to a computer.

Yu is lacking in that his cylindrical USB memory stick does not double as a pen in the manner claimed.

Chao's figure 6 is particularly instructive. On the end of a cylindrical USB device having a USB port at one end of the cylinder is attached a pen tip 2 that screws in to an upper cylindrical portion 2 that is hollow for receiving the USB device.

*A combination of Yu's teaching with Chao's teaching can be very straightforwardly seen by comparing figure 5 of Yu with figure 6 of Chao. Cylinder 100 of Yu is simply substituted for the upper portion 2 shown in figure 6.*

In view of Chao's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known pen tip of Yu in the cylindrical reader of Chao because a dual use pen and USB device is more versatile as Chao demonstrates.

Re claim 2: A screw structure can be seen at 33 and 61 of figure 6 of Chao.

Re claim 3: A clip such as that on the upper portion 2 of figure 1 of Chao would be obvious to include to complete the pen / card-reader combination as per claim 1 above. The clip of Chao is typically rotatable; this examiner has on his desk such an implement. If the clip of 2 were rotated about a cylindrical portion such as in figure 5 of Yu, it would indeed cover at least one slot 52b.

Re claim 4: Yu (figure 5, 51) and Chao (figure 6, 7) both show USB ports.

Re claim 5: Flash memory cards (column 2, line 65) are one of several memory cards read by Yu.

Re claim 6: PC cards which act as wireless modems are widely known (Liu et al., US Pub. No. 2004/0100748 is exemplary), and to place such a in one of the several slots in the reader of Yu, figure 5 would achieve the desired connectivity.

The motive of the above modification is to achieve wireless connectivity in a device that may have a USB port but not the requisite card reader port.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yu (US Pub No. 2004/0080989; different inventor from above) teaches a pen-based USB memory stick.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DH



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PRIMARY EXAMINER